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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,475	04/23/2001	Michael J. Sullivan	P-4628-D1-1-C1-1	5756
24492	7590	03/02/2004	EXAMINER	
THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY P.O. BOX 901 425 MEADOW STREET CHICOPEE, MA 01021-0901			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 03/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,475

Applicant(s)

SULLIVAN ET AL.

Examiner

David Buttner

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17, 19-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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8/87085 (based on review of US 6210293) does not provide basis for the current claims. The alleged parent lacks metal fillers, reaction injection molding, specific gravity range, dual cores and location of filler in such a dual core. None of applicant's claims can rely on this application's filing date.

9/562773 (based on review of US 6495633) does not provide basis for the current claims. The alleged parent lacks metal fillers, specific gravity range and location of filler in a dual core. None of applicant's claims can rely on this application's filing date.

The effective filing date for the instant claims is 4/23/01.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14, 17 and 19-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Requiring the core layer to be free of density adjusting fillers is not clearly taught in the specification as filed. In fact, applicants own examples (table 20) included ZnO in that layer. ZnO qualifies as a density adjusting filler according to applicant (table 19; page 54 lines 27)

Claims 1-14, 17 and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if all density adjusting fillers are being excluded from (i) or merely metal/metal alloys are being excluded.

Claims 1-14, 17, 19-23, 25, 26 and 28 are rejected under 35 U.S.C. 102(b/e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melvin '562 Patent.

Melvin discloses golf balls having a center core, outer core and at least two cover layers (col. 5., lines 1-4). The center core contains tungsten and the outer core does not (example 1). Also note teachings that the center core has a higher specific gravity than the outer core (col. 5 line 1) and that the center and outer core can be the same composition "except for the specific gravity controlling filler" (col. 5 line 26).

The outer cover can be a urethane (col. 18, lines 38,50). The outer cover is softer than the inner cover (col. 5, line 3) and is preferably 50 or less on the shore D scale (col. 15 line 13). The inner cover should have a shore D above 65 (col. 12 line 35).

Claims 1-14, 17 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Melvin '562 Patent in view of Sullivan '119.

Melvin does not suggest titanium filler or reaction injection molding the urethane cover. Sullivan lists titanium and tungsten as alternative metal fillers for golf balls.

It would have been obvious to substitute Melvin's tungsten with titanium to adjust the density to any desired level.

Sullivan also teaches reaction injection molding is one method of placing urethane cover on golf balls (col. 19, line 61).

It would have been obvious to use any known techniques to mold Melvin's urethane cover (including RIM).

Applicant's arguments filed 10/15/03 have been fully considered but they are not persuasive.

Applicant argues "formed from a thermoset material, a thermoplastic material or combinations thereof" supports the exclusion of fillers in the outer core.

The mere absence of a positive recitation is not basis for an exclusion (MPEP 2173.05(i)).

Figures 4-6 do not mention fillers either. How can these figures support a metal filled core surrounded by an unfilled layer?

Applicant's argument regarding Melvin ignore the cited example showing a metal filled center core surrounded by an outer core without metal filler. Applicant also ignores Melvin's teachings that the center core has a higher density than the outer core (col. 5, line 1) and the "except for the specific gravity controlling filler" statement (col. 5 line 26). This suggests placing filler in the center core, but not in the outer core.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (571) 272-1084. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/af
February 23, 2004

David Buttner